



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/591,151 | 11/13/2007 | Yingxin Huang | HW 0410776US | 6168 |
| 74365 7590 06/30/2010 Slater & Matsil, L.L.P. 17950 Preston Road, Suite 1000 Dallas, TX 75252 | | | | |
| EXAMINER D AGOSTA, STEPHEN M | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2617 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 06/30/2010 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@slater-matsil.com

Office Action Summary

Application No.

10/591,151

Applicant(s)

HUANG ET AL.

Examiner

Stephen M. D'Agosta

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6-21-2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 11-19 is/are rejected.
- 7) ☒ Claim(s) 7-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 6-21-2010 have been fully considered but they are not persuasive.

1. The applicant's response regarding Priority and their claim to Priority is satisfactory. Thank you.

2. The drawing changes are noted. Thank you.

3. The applicant argues (page 2-3) that the prior art does not teach a "list configured in the mobile", the "MT deciding according to the information of the TE identity in the list whether to accept the request" and "if the decision is made to accept the request, the MT acquiring an identity of the user identity card". The examiner disagrees for several reasons:

i. The concept of a "list" is broad and can mean many different things, eg. an amount of memory whereby data is stored regarding the device, etc..

ii. The applicant's AIPA figure 3 clearly shows that the MT accesses data (eg. a list in memory) in order to acquire an identity (step #303).

iii. Furthermore, the applicant's AIPA figure 3 shows that the MT and USIM make a decision as to whether an identity is granted (MT "asks" USIM to make an authentication decision, #308).

iv. The examiner also added Gehrmann and Haverinen who teach stored data (in memory, lists, etc) which are used to authenticate among the different devices (eg. mobile, TE, network, etc). Hence one skilled understands that multiple parameters can be stored (in memory, lists, etc) to allow for different configurations/identities depending upon what device(s) are connecting to what network(s).

v. Lastly, the concept of merely having one device access another device in order to download data/parameters/configurations is well known and can occur

between components on the same device, across a LAN, via wired or wireless conveyance or clear across the world.

If this is where the applicant believes novelty in their concept is found, they should consider amending the claim with a more detailed/narrower design such that it fully overcomes the (broader) teachings of the prior art.

4. The applicant argues that claim 14 is "different" than that which is reflected in the office action. The examiner disagrees since the concepts of authentication and success/termination are found in the office action. The rejection clearly addresses these steps:

"...identity of the user identity card to the TE, and terminating the procedure (Figure 3 culminates in the Mobile accepting the identity request and returning an identity to the TE whereby the mobile/TE can access the network. Note that step 311 teaches either an accept/yes message or a failed/no message whereby the failure will result in termination/rejection. The examiner also notes that it would be inherent for a security function to either allow or fail a user's access to a network, hence terminating the procedure is the only other possibility if the user is not authenticated properly).."

5. Since the claims were not modified in scope, the examiner has NOT copied/pasted the previous office action into this Final office action. Hence the rejection of the claims as per the 4-2-2010 office action is maintained and incorporated herein.

- No Claim(s) is/are allowed.
- Claim(s) 1-6 and 11-19 is/are rejected.
- Claim(s) 7-10 is/are objected to as being novel.

6. The examiner believes a more favorable outcome may occur if the applicant were to amend the claims with the novel material as pointed out above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis West can be reached on 571-272-7859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/591,151

Page 5

Art Unit: 2617

/Stephen M. D'Agosta/

Primary Examiner, Art Unit 2617